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TO: Mail Stop: Appeal Brief-Patents

RE: PATENT APPLICATION ATTORNEY DOCKET NO. 10004747-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Tamra L. Thomason

CONFIRMATION NO: 8559

SERIAL NO.: 09/916,537

GROUP ART UNIT: 2176

FILED: July 27, 2001

EXAMINER: Sain, Gautam

SUBJECT: System and Method For Completing Forms

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2. Transmittal Letter For Response/Amendment (1 page)
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PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400ATTORNEY DOCKET NO. 10004747 -1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Tamra L. Thomason

Confirmation No.: 8659

Application No.: 09/916,537

Examiner: Sain, Gautam

Filing Date: July 27, 2001

Group Art Unit: 2176

Title: System And Method For Completing Forms

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF REPLY BRIEFTransmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on March 22, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

Tamra L. Thomason

By Nathan R. Rieth

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MAY 22 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Docket No. 10004747-1

Inventor(s): Tamra L. Thomason

Confirmation No.: 8559

Serial No.: 09/916,537

Group Art Unit: 2176

Filed: July 27, 2001

Examiner: Sain, Gautam

For: System and Method for Completing Forms

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed March 22, 2006 has been carefully considered.

In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer, various responses to arguments contained in Applicant's Appeal Brief. However, Applicant respectfully submits that these responses are deficient and improper for at least the reasons provided herein as follows.

**The References Do Not Teach or Suggest All Claim Limitations, Nor are the
References Reasonably, Logically, or Properly Combinable**

Applicant's claim 1 recites in part, "*reading a user data card to determine a network location at which user information to be added to a form is stored*". None of the references, alone or when *improperly* combined, teach such limitations.

Kennedy teaches a system for automatically completing forms that are retrieved from web sites. In Kennedy, *user information* is not stored at *a network location*, and there is no reason to *determine a network location at which user information to be added to a form is stored*. In Kennedy, user information that can be used to populate various forms from various web sites is stored on the client computer itself, in a dictionary 207. Kennedy, column 6, lines 19-37; Figure 2. In Kennedy, a web browser accesses a form on a web site and associates common field labels in the form with data that has been previously entered by a user (e.g., when the user filled out a different form from a different web site). User information previously entered is stored in the client computer's dictionary 207, and the web browser on the client computer can use this information in the dictionary to automatically populate various web forms from various web sites. Again, however, the *user*

information is not stored at a network location, and Kennedy does not need to determine a network location at which user information to be added to a form is stored.

Thus, Kennedy does not teach the limitation of “*reading a user data card to determine a network location at which user information to be added to a form is stored*”. To the contrary, Kennedy clearly and absolutely teaches away from this limitation. Any assertion that Kennedy could be properly combined with or modified by any reference for the purpose of teaching this limitation is, respectfully, unsustainable on its face. Such a modification of Kennedy would be to throw out Kennedy’s teachings altogether.

As made clear above, the limitation of “*reading a user data card to determine a network location at which user information to be added to a form is stored*” could have no place or purpose whatsoever in Kennedy’s system, and would completely and fundamentally change the entire operation of Kennedy’s system. Yet, the Examiner proposes just such a modification to Kennedy and points to the Goheen reference for support. However, the Examiner provides no reasonable justification for why anyone of skill in the art would be motivated to modify Kennedy in this way, nor does the Examiner point to any teaching at all that would suggest how such a modification could be purposefully achieved. Again, modifying Kennedy’s system in the suggested manner would be to simply throw out Kennedy’s system and start from scratch.

Goheen teaches a system used in airports for enabling airline passengers to more quickly and easily board their aircraft. When an airline passenger makes a reservation, the passenger is issued an identification card that stores passenger information. The passenger swipes the card at an airport ATM which reads the passenger information and displays

various flight related information to the user, such as the gate and time of departure. The ATM can also print a "print-out tape" having this same information. At the boarding gate, a flight attendant swipes the identification card through a magnetic card reader to confirm that the passenger has a reservation and is authorized to board the aircraft.

The Examiner points to the Goheen reference and asserts it is combinable with Kennedy to teach the limitations of "*reading a user data card to determine a network location at which user information to be added to a form is stored*". Yet, Goheen says nothing whatsoever about filling out forms. It is clear from the above description of Goheen that, like Kennedy, Goheen does not teach these limitations of Applicant's claim. Neither Goheen nor Kennedy teach reading a user data card to determine a network location where user information to be added to a form is stored.

The Examiner has merely thrown these references together in an attempt to construct the limitations of Applicant's claim, which is improper. The Examiner's alleged motivations for combining Kennedy and Goheen include that these references "have as the core technology, a database on a central (or main) site which is disparate from the client machines (i.e., a network) which is accessible to multiple users, where the database contains user data that is used to complete a form". Examiner's Answer, page 13, lines 1-4. However, as noted above with respect to Kennedy, this is clearly not true. The user information for completing a web form in Kennedy is stored on the client computer itself, in a dictionary 207, not on a central database. Kennedy, column 6, lines 19-37; Figure 2. Additional alleged motivation for combining Kennedy and Goheen is that "each of the references attempt to resolve the same problem as the invention of the Appellant, which is to store data in a central database and later recall that information to fill out a

form and thus reduce time and effort in filling out form [sic] by a user". Examiner's Answer, page 13, lines 19-22. Again, this is clearly not true. In Kennedy, the user information for completing a web form is stored on the client computer itself, in a dictionary 207, not on a central database. Kennedy, column 6, lines 19-37; Figure 2. Furthermore, in Goheen there is nothing to indicate that Goheen is attempting to resolve a problem of storing data in a central database to later recall that information and fill out a form to reduce the time and effort in filling out a form by a user. Goheen says nothing whatsoever about filling out forms.

Thus, the alleged motivation for combining Kennedy with Goheen is unsupported by evidence and the combination is improper. The Examiner does not present any evidence that Kennedy alone does not already adequately facilitate the population of web forms with previously used data values. Nor is there any evidence presented that demonstrates that Kennedy is deficient in facilitating the population of web forms with previously used data values. Accordingly, there is no reason why someone aware of the teachings of Kennedy would look to Goheen for teachings directed to the subject matter already disclosed in Kennedy. In view of the lack of any supporting objective evidence of an improvement provided by the combination, it is clear that the motivation can only result from improper reliance upon Applicants' disclosure. However, a combination made in this manner is improper. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, as noted above, the combination of any reference with Kennedy to arrive at the limitations of Applicant's claim

1 is improper, because such a modification of Kennedy completely changes the teachings of Kennedy. Applicant respectfully submit the Office has failed to meet its burden of establishing proper motivation for the 103 combination and the 103 rejection is improper for at least these reasons.

Applicants also respectfully submit that even if the references are combined, the combination fails to disclose or suggest positively recited limitations of claim 1 and the Office has failed to establish a proper prima facie 103 rejection for this additional reason.

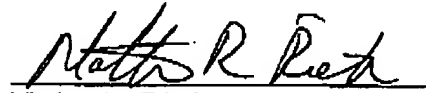
For these and other reasons already noted in Applicant's Appeal Brief filed December 22, 2005, Applicant's claims are patentable over the applied prior art references and the rejection of these claims should be withdrawn.

VII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:



Nathan R. Rieth

Registration No. 44,302

I hereby certify that this correspondence is being
facsimile transmitted to the U.S. Patent and Trademark
Office on May 22, 2006 to PTO fax number (571) 273-8300.
Typed Name of Person Sending Facsimile: Betty Hinkle
Signature: 